

Reconsideration and withdrawal of the rejections of this application and consideration and entry of this paper are respectfully requested in view of the herein remarks, which place the application in condition for allowance.

### I. STATUS OF CLAIMS AND FORMAL MATTERS

Claims 1-22 are now pending. New claims 19-22 are related to the originally filed claims as follows: Claim 19 incorporates the elements of claim 1-4; claim 20 incorporates the elements of claim 11 and claim 19; claim 21 incorporates the elements of claims 12, 15 and 19 and claim 22 incorporates the elements of claims 11 and 21. No new matter has been added by this amendment.

Claims 4 and 5 were not subject to any 102 or 103 rejection and the 112 rejection did not encompass claims 4 and 5. Therefore, claims 4 and 5 are presumed to be allowable if rewritten in independent form.

It is submitted that the claims, herewith and as originally presented, are patentably distinct over the prior art cited in the Office Action, and that these claims were in full compliance with the requirements of 35 U.S.C. § 112. The amendments of the claims, as presented herein, are not made for purposes of patentability within the meaning of 35 U.S.C. §§§§ 101, 102, 103 or 112. Rather, these amendments and additions are made simply for clarification and to round out the scope of protection to which Applicants are entitled.

### II. THE 35 U.S.C. 112, 2<sup>nd</sup> PARAGRAPH REJECTION HAS BEEN OVERCOME

Claims 2 and 13 were rejected as allegedly being vague and indefinite for using the phrase “polymer substance having a length or a size larger than...”. This rejection is not understood as the remainder of the claim provides a point of comparison, i.e. “...larger than gaps among the fine particles”, which would be understood by those with skill in the art. If the Examiner’s confusion resulted from the use of the term “a length”, this term has been deleted from the claims.

Please note that the applicants are to be afforded a great deal of deference in defining their invention. MPEP 2173.02 states in part:

“The examiner’s focus during examination of claims for compliance with the requirement for definiteness of 35 U.S.C. 112, second paragraph is whether the claim meets the threshold requirements of clarity and precision, **not whether more suitable language or modes of expression are available**. When the examiner is satisfied that patentable subject matter is disclosed, and it is apparent to the examiner that the claims are directed to such patentable subject matter, he or she should allow claims which define with a reasonable degree of particularity and distinctness. Some latitude in the manner of expression and the aptness of terms should be permitted even though the claim language is not as precise as the examiner

might desire. *Examiners are encouraged to suggest claim language to applicants to improve clarity or precision of the language used, but should not reject claims or insist on their own preferences if other modes of expression selected by applicants satisfy the statutory requirement.*

MPEP 707.07(g) states in part “[c]ertain technical rejections (e.g. negative limitations, indefiniteness) should not be made where the examiner, recognizing the limitations of the English language, is not aware of an improved mode of definition.” If these amendments are deemed not to overcome the 112, 2<sup>nd</sup> paragraph rejection, then the applicants request that the Examiner provide “an improved mode of definition”.

### **III. THE 35 U.S.C. 103 REJECTIONS HAVE BEEN OVERCOME**

Claims 1-3 and 6-18 were rejected as allegedly being obvious over Ichimura et al. (U.S. Patent 6,456,416 - “Ichimura”).

In order to establish a *prima facie* case of obviousness, all of the claimed limitations must be taught or suggested. see MPEP 2143.03. However, Ichimura lacks any teaching for a “layer comprising a molecule having a size larger than gaps among the fine particles.”

If the Examiner’s position is that optimizing the particle shape and size to improve optical properties and optimizing the composition of the laminate to obtain “the desired properties” results in a “layer comprising a molecule having a size larger than gaps among the fine particles.”, MPEP 2144.05 section II (Optimization of Ranges) states that “A particular parameter must first be recognized as a result-effective variable, i.e., a variable which achieves a recognized result, before the determination of the optimum or workable ranges of said variable might be characterized as routine experimentation. *In re Antonie*, 559 F.2d 618, 195 USPQ 6 (CCPA 1977).” However, there is no teaching or disclosure from within the Ichimura reference which states that particle shape, size or composition of laminate are results-effective variables that lend themselves to optimization. Even if Ichimura had a teaching that any or all of the elements were results-effective variables, given that one of ordinary skill in the art would only have the Ichimura reference before them and not the applicants’ claims, there is no teaching or guidance that the process of optimization of conditions could only be in the direction required to approximate the applicants’ claimed invention, i.e. why would one of ordinary skill in the art only be directed to optimize completely in the direction of the applicants’ claimed invention (i.e. “layer comprising a molecule having a size larger than gaps among the fine particles.”) rather than only partially in the direction of the applicants’ claimed invention or away from the applicants’ claimed invention?

As Ichimura does not teach all of the applicants claimed limitations, there is no basis for *prima facie* case of obviousness and therefore, the rejection of claims 1-3 and 6-18 under 35 U.S.C. 103 can properly be withdrawn.

**REQUEST FOR INTERVIEW**

In the interest of adhering to the tenets of compact prosecution and obtaining good customer service (see page 7 of the FY-2004 Performance and Accountability Report), the applicants request that the teachings of MPEP 707.07(j), sections II and III be applied, especially with regard to the offer of suggestion for correction by the Examiner if the rejections are upheld.

In accordance with MPEP 713.01, section III, should any issue remain as an impediment to allowance, an interview with the Examiner and SPE are respectfully requested; and, the Examiner is additionally requested to contact the undersigned to arrange a mutually convenient time and manner for such an interview (“An interview should normally be arranged for in advance, as by letter, facsimile, electronic mail, telegram or telephone call, in order to insure that the primary examiner and/or the examiner in charge of the application will be present in the office.” *Id.*).

**CONCLUSION**

In view of the remarks and amendments herewith, the application is believed to be in condition for allowance. Favorable reconsideration of the application and prompt issuance of a Notice of Allowance are earnestly solicited. The undersigned looks forward to hearing favorably from the Examiner at an early date, and, the Examiner is invited to telephonically contact the undersigned to advance prosecution. The Commissioner is authorized to charge any fee occasioned by this paper, or credit any overpayment of such fees, to Deposit Account No. 50-0320.

Respectfully submitted,

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